

## **REMARKS/ARGUMENTS**

### **Posture of the Application**

Claims 1-15 are pending, with claims 9-11 and 16-19 withdrawn from consideration. Claims 1, 2, 4, 6, and 13 stand rejected under 35 U.S.C. §102(e) and claims 1-8 and 12-15 stand rejected under 35 U.S.C. 103(a). Claims 1 and 13 are amended herein and claim 20 is new, leaving claims 1-8, 12- 15, and 20 for consideration upon entry of this amendment. Support for the amendments can be found at least in Figures 1-4, 5A, and 5B, as well as on pages 6 and 7 of the specification as originally filed. No new matter has been added.

### **Election/Restrictions**

As required under 35 U.S.C. §121, Applicant confirms the provisional election with traverse to prosecute the invention of Species I (Figures 1-4, 5A, 5B), readable on claims 1-8 and 12-15. Newly added claim 20 is also readable upon the elected species. Applicant acknowledges that claims 9-11 and 16-19 are withdrawn from further consideration by the Examiner.

Applicant notes that upon the allowance of a generic claim (e.g., currently it is agreed that claims 1 and 13 are generic), Applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141.

### **Claim Rejections -35 USC §102**

Claims 1, 2, 4, 6 and 13 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,659,429 to Shoji. Applicant respectfully traverses this ground of rejection.

To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988). Moreover,

the single source must disclose all of the claimed elements “**arranged as in the claim.**” (Emphasis added.) *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

With respect to claims 1, 2, 4, 6, and 13, the Examiner alleges that Shoji discloses a body 3; a shaft 11 rotatably supported by the body, the shaft having a longitudinal axis; a power-operated driver (26A or 26B) connected to the shaft; and a power connector 11 A; and a guide member 21 perpendicular to the longitudinal axis of the shaft.

It is noted that Shoji specifically discloses a winch having a drive means 26 that may be an electric tool 26, such as an electric drill, an output shaft of which is connected by an attachment 26 A' which is engaged with the rectangular shaft portion 11 *a* of the input shaft 11; an electric motor 26 B joined to the input shaft 11; or a manually-operated rotary handle 26 C engaged on the rectangular shaft portion 11 *a* of the input shaft 11. See FIG. 1 and Col. 2, lines 61-67.

Shoji does not teach or suggest a pneumatic motor or a hydraulic motor as claimed in claims 2 and 6, respectively. Thus, it is respectfully submitted that Shoji does not anticipate claims 2 and 6.

More significantly, Shoji discloses a winch 1 having a U-shaped support frame 3 enclosing winding drum 17 or spool defined by outboard flanges 21. See FIG. 1 and Col. 1, line 62 – Col. 2, line 48. Accordingly, Shoji does not teach or suggest a structure as defined in amended claims 1 and 13. Specifically, Shoji does not show or suggest structure in which the shaft is defined as having a slotted end which is dimensioned and configured to retain the strap for winding it about the shaft, the slotted end being defined by a slot extending parallel to the longitudinal axis of the shaft, the slotted end allowing the strap formed into a coil to be removed from the shaft by axially translating the formed coil along the longitudinal axis over the slotted end. Thus, it is respectfully submitted that claims 1 and 13, including claims depending therefrom, i.e., at least claims 2, 4, and 6, for example, define over Shoji.

Shoji would not render the amended claims obvious under 35 USC 103, because

Shoji actually teaches away from the now-claimed structure.

**Claim Rejections -35 USC §103**

Claims 1-8 and 12-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,311,288 to Galland in view of U.S. Patent No. 5,692,735 to Aho et al. Applicant respectfully traverses this ground of rejection.

For an obviousness rejection to be sustainable, the Examiner must meet the burden of establishing a *prima facie* case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Establishing a *prima facie* case of obviousness requires that all elements of the invention be disclosed in the prior art. *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (In that case, claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed. The court, however, found that this teaching does not require that the output pump be run at the claimed speed as to entrain air in the ingredients contained in the mixing chamber. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.).

See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references). MPEP § 2143.01.

The Examiner contends that Galland discloses the strap winding mechanism mounted on a truck, but acknowledges that Galland does not disclose the strap winding mechanism being powered. However, the Examiner alleges that Aho et al. teach a winding mechanism attached to a vehicle and powered by the vehicle's power steering

system. The Examiner concludes that it would have been obvious to one of ordinary skill in the art to provide Galland with a motor powered winding machine as taught by Aho et al. to provide more pulling power.

Galland discloses a strap-winding mechanism for winding truck load straps, the mechanism comprising a stanchion having a clamp at the lower end thereof for generally vertical demountable attachment to any selected stake hole of a conventional flat bed truck. The upper end of the stanchion has a plurality of generally horizontal journal apertures at various azimuthal attitudes for selective journalling of a reel handle and a bifurcated open-ended reel assembly in any of the journal apertures. The reel handle and reel spindle are threaded complementarily and thus readily assembled and readily reversible in the journal apertures, and readily disassembled for compact storage. See the Abstract of Galland.

More specifically, Galland discloses that the strap reel assembly 14 has a hub 34 which can suitably be made hexagonal and of a size to accommodate a conventionally sized box wrench. The hub 34 is joined along the sides thereof to reel prongs 36 and 36' by, for instance, brazes 38 and 38'. On the opposite side of stanchion 10, a reel handle 12 is fixed end-to-end with a reel shaft 28. In a typical assembly of the components, the shaft 28 is first inserted through one set of journal apertures, for instance 18 and 18', so that a threaded male portion 24 of the shaft 28 passes first through the apertures 18 and 18'. Col. 3, lines 10-20.

Galland does not teach or suggest, and in fact teaches away from, the structure defined in amended claims 1 and 13. Specifically, Galland teaches away from a one-piece shaft rotatably supported by the body, the shaft defined at one end having a slotted end being dimensioned and configured to receive the strap for winding it about the shaft, the slotted end being defined by a slot extending parallel to the longitudinal axis defining the shaft, the slotted end allowing the strap formed into a coil to be removed from the shaft by axially translating the formed coil along the longitudinal axis over the slotted end; and a power-operated driver connected to the shaft to rotate the shaft about its longitudinal axis, as in claim 1 and similarly claimed in claim 13. Thus, it is respectfully submitted that independent claims 1 and 13, including claims depending therefrom, i.e., claims 2-12, 14-15, and 20, define over Galland in view of Aho et al.

Furthermore, Galland does not teach or suggest the structure now defined in claim 13. Specifically, claim 13 requires a guide member mounted to one of the body and the shaft and defining a surface in generally perpendicular relation to the longitudinal axis of the shaft, the surface extending at least to the slot to contact an edge of the strap being wound into the coil such that an edge of the coil is formed coplanarly with the guide surface. It is respectfully submitted that claim 13, including claims depending therefrom, i.e., claims 14, 15, and 20, define over Galland in view of Aho et al.

In addition, it is to be noted that if an Examiner's proposed modification of the reference would render the modified reference unsatisfactory for its intended purpose, then there is no suggestion or motivation to the art to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Further, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (In that case, claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. The patentee taught that the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection, holding that the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." (Emphasis added.) 270 F.2d at 813, 123 USPQ at 352 (CCPA 1959.). MPEP §2143.01.

Here, Galland specifically teaches away from the modification suggested by the Examiner. More specifically, Galland discloses with respect to discussing the prior art and problems associated therewith that "[t]his mechanism does not provide flexibility of use or ease of storage in that its reelshaft and crank are integral and journaled in a fixed yoke so that any material on the reel is not readily removable as a wound unit." (Emphasis added.) Col. 1, lines 14-17. Galland further discloses that "[i]n addition, the

device is not arrangeable in a plurality of positions to allow for possible obstructions to the use of the device, and the disclosed embodiment of this device requires the permanent attachment of mounting brackets to the truck bed for the device even though it may be used only occasionally. (Emphasis added.) Col. 1, lines 36-42.

Thus, modification of Galland as suggested by the Examiner would render the prior art invention of Galland being modified unsatisfactory for its intended purpose, i.e., easily assembled and disassembled for compact storage and a plurality of mounting positions. Accordingly, it is respectfully submitted that there is no suggestion or motivation to the art to make the Examiner's proposed modification.

Further, since the proposed modification or combination of the prior art (i.e., Galland) would change the principle of operation of the prior art invention being modified, the teachings of the references are not sufficient to render the claims *prima facie* obvious.

## Conclusion

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued.

If the Examiner has any questions with regard to the intent and purposes of the amendments set forth herein, the Examiner is cordially invited to telephone the undersigned to further this application toward issuance.

In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicant's attorney hereby authorizes that such fee be charged to Deposit Account No. 06-1130.

Respectfully submitted,

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